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| APPLICATION NO.       | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------|-------------|----------------------|---------------------|------------------|
| 10/663,554            | 09/16/2003  | Bret M. Berry        | 31132.172           | 2585             |
| 46333                 | 7590        | 07/26/2006           | EXAMINER            |                  |
| HAYNES AND BOONE, LLP |             |                      | SWIGER III, JAMES L |                  |
| 901 MAIN ST           |             |                      | ART UNIT            |                  |
| SUITE 3100            |             |                      | PAPER NUMBER        |                  |
| DALLAS, TX 75202      |             |                      | 3733                |                  |

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/663,554

**Applicant(s)**

BERRY, BRET M.

**Examiner**

James L. Swiger

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 14-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 22-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 5/5/2006 have been fully considered but they are not persuasive. Examiner has noted and considered the new claims.

With regards to the arguments over the "young patent," it should be noted that the tubular body the axle, referred to as 108, should have been correctly identified as 142, wherein it is a rotatable tubular body that is affected by the rotation of the axle (120). Therefore the vague "tubular body expands" in claim 1, line 7, would not be supported, allowable subject matter in the last line of claim 23 stating "the tubular body to rotate relative..." as the tubular body of claim 1 still is capable of rotating relative to the pair of end plates as they open.

For the reasons above, the following rejections still apply.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 11-12 and 22-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Young et al. (U.S. Patent No. 6,190,414). Young et al. disclose an apparatus for installing a vertebral implant assembly comprising a pair of endplate assemblies (Fig. 9), a tubular body (108), an axle having a proximal and distal end

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(120), a set of gears (138) capable of connecting to the proximal end of the axle, and an engager device (136) connected to the gears capable of rotating the tubular body to expand the vertebral implant assembly (Col. 5, lines 25-35). The device of Young et al. further comprise an outer casing (118), a handle section (106) that extends through the outer casing and partially into the handle (cutout portion, Fig. 7) and that is fixedly connected (110) and rotationally engages the outer casing since it must be able to move the shaft. The device also includes a handle that has a first portion fixed to the outer casing (110), and a second portion to rotate the axle (112) that may also be considered a cap member, a plurality of gears (136 and 156), an engager device (136) that is comprised of teeth, a secondary gear with teeth (156) capable of translating the rotating axle into the rotation of the toothed section. Young et al. also disclose a holding instrument (124) capable of attachment to the endplate assemblies and outer casing (see fig. 10).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. '414 in view of Maroney et al. (U.S. Patent No. 6,277,123). Young et al.

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disclose the claimed invention except for a positioning mechanism with selectively pivotable arc portions. Maroney et al. disclose a device having pivoting, arcuate arms (21) that allow for a better grip on the prosthesis when inserting for insertion at the proper depth, or even for accommodating various sizes of prostheses in use of the invention (Col. 1, lines 30-67 to Col. 2 lines 1-3). It would have been obvious one having ordinary skill in the art at the time the invention was made to construct the device of Young et al. having at least pivotin, arcuate positioning mechanisms in view of Maroney et al. in order to have a better grip on the prosthesis when inserting it into the vertebral area.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. '414 in view of Keller (U.S. Patent Publication No. 2003/0229355). Young et al. discloses the claimed invention except for a pair of alignment arms and an alignment member to align the vertebral implant as the assembly expands. Keller et al. disclose a device having parallel alignment arms (57, and see profile Fig. 6, left) and an alignment member to facilitate proper alignment as the device expands (52a and 52b). Keller discloses that these items help keep the instrument body in alignment and allow the prosthesis holder/alignment members to move exclusively perpendicular and parallel to each other (par. 0018). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Young et al. having at least alignment arms and alignment members in view of Keller to keep the instrument body in alignment and more effectively deliver the implant in use of the instrument.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

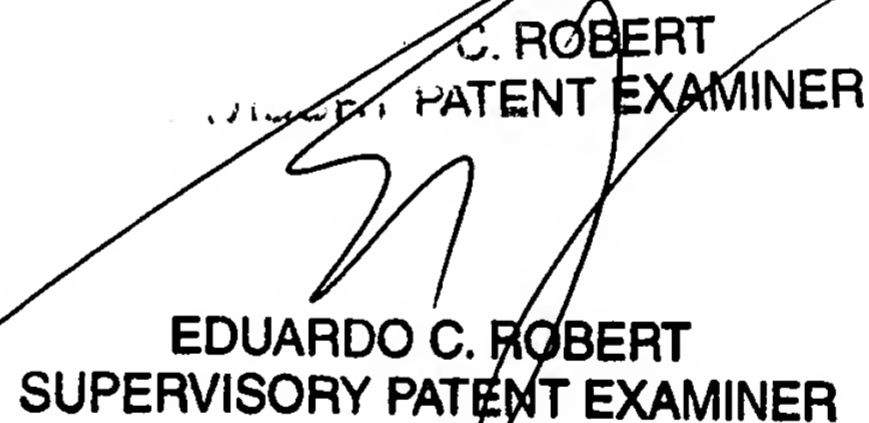
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLS



7/19/06



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